

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: A8973

Guyton P. SWINDELL, et al.

Appln. No.: 10/607,646

Group Art Unit: 3729

Confirmation No.: 2684

Examiner: Thiem D. PHAN

Filed: June 27, 2003

For: APPARATUS AND METHOD FOR TAUT SHEATH SPLICING OF ALL-DIELECTRIC, SELF-SUPPORTING FIBER OPTIC CABLE

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated November 26, 2008. Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT	4
CONCLUSION	6

STATUS OF CLAIMS

Claims 6-10 and 12 stand finally rejected under 35 U.S.C. § 103(a) as being anticipated by Smith et al. (U.S. Patent No. 5,696,864) in view of Forrester (U.S. Patent No. 5,867,624).

Claim 11 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Forrester et al. and further in view of Applicants' Admitted Prior Art (AAPA).

The rejections of claims 6-12 are being appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant requests that the following rejections be reviewed:

1. Claims 6-10 and 12 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 5,696,864) in view of Forrester (U.S. Patent No. 5,867,624).
2. Claim 11 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Forrester et al. and further in view of Applicants' Admitted Prior Art (AAPA).

No other grounds of rejection or objection currently are pending.

This appeal is directed to claims 6-12.

ARGUMENT

1. The rejection of claims 6-10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Forrester

Appellant respectfully requests the members of the Board to reverse the aforementioned rejection of claims 6-10 and 12 under 35 U.S.C. §103(a) as allegedly being unpatentable over Smith in view of Forrester.

In the Examiner's Answer, the Examiner makes a small, but significant change in the rejection of the claims. Specifically, the Examiner now states that Smith discloses:

“applying a clamp **system** (Fig. 1, items **20**, 21, 22 & **24**) to a first position of a first fiber optic cable (Fig. 1, 18)” (emphasis added) Answer, page 3.

However, in both the Final Office Action of June 19, 2007 (page 2) and the Office Action of December 11, 2006 (page 3), the Examiner stated that Smith disclosed:

“applying a clamp (Fig. 1, items 21 & 22) to a first position of a first fiber optic cable (Fig. 1, 18)”

Appellants first note that the claim language is “applying a clamp to a first portion of a self-supporting first fiber optic cable.” Claim 6. By adding “system” and item nos. 20 and 24 of figure 1, the Examiner is apparently conceding that Smith does not disclose or suggest the claimed “clamp.” The Examiner needs to rely on item nos. 20 and 24 in order to respond to Appellants argument that item nos. 21 and 22 cannot be the claimed clamp because they do not connect to a bail (or strand 12) or cable 18, respectively. The Examiner's rationale for doing this appears to be based on his position that

Appellants do not specify the exact clamp applied in the invention, such as the items 12, 28 and 30 of Figure 1 disclosed as clamp (sic) in the specification

and recited in claims 6 and 12 ... to clarify the claimed invention while attempting to call it the “wedge clamp” later in the remarks and not in the claims.” Answer, pages 7-8.

While it is true that item nos. 28 and 30 in Figure 1 of Appellants application are clamps, they cannot be the claimed clamp. The claimed clamp must be connected to both the bail and first fiber optic cable. Clamps 28 and 30 do not meet this requirement. Appellants also respectfully disagree with the Examiner’s statement that Appellants do not specify the exact clamp applied in the invention. On pages 7 and 8 of Appellants’ brief, Appellants explicitly identify item no. 12 as the claimed clamp. Appellants also note that they are not “reading the specification into the claims,” as asserted by the Examiner on Page 9 of the Answer; rather, Appellants are construing the “clamp” in the context of the other limitations of the claims.

The Examiner next argues that he never suggested the total elimination of the strand (Answer, page 9). That may be the Examiner’s new position; however, in the Advisory Action, he stated that it would be obvious to modify Smith as taught by Forrester “in order to eliminate the unnecessary extra costs of the strand cable (Fig. 1, 12) along the *whole length of the fiber cable* (Fig. 1, 18)” (emphasis added) Advisory Action, page 2.

The Examiner’s final argument is that “it’s just a matter of apply new technology to the old one to save costs from installing thousands of miles of unnecessary, additional strand cable along all the communication lines while avoiding the ‘polluting view effect’ to the environment with many cables tangled high up in the sky.” Answer, page 9. This misses the point. It is not simply a matter of applying new technology to old technology - many inventions arise out of the application of new technology to old technology. Rather, it must be obvious to modify the prior

art to arrive at the specific claimed invention. In this case, one of skill in the art at the time of the invention, having both Smith and Forrester, would not have found it obvious to arrive at the claimed invention.

2. The rejection of claim 11 under 35 U.S.C. § 103(a) as being anticipated by Smith et al. in view of Forrester and further in view of AAPA

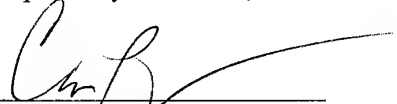
Appellant respectfully requests the members of the Board to reverse the aforementioned rejection of claim 11 under 35 U.S.C. §103(a) as allegedly being unpatentable over Smith et al. in view of Forrester and further in view of AAPA.

Appellant disagrees with these rejections because the cited references fails to disclose or suggest all of the claim limitations for the same reasons as described above in section 1.

CONCLUSION

For the above reasons as well as the reasons set forth in this Reply Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Brief is respectfully requested.

Respectfully submitted,



Carl; J. Pellegrini
Registration No. 40,766

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 26, 2009